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UNFAIR COMPETITION BY THE DECEPTIVE USE OF ONE'S OWN NAME.

THE protection of manufacturers of established reputation against unfair competition is a branch of the law which has developed rapidly during recent years. Various causes have combined to multiply the number of valuable trademarks and trade-names, and to widen the area in which they are known. "Hood's Sarsaparilla" is blazoned on rocks and fences from New York to San Francisco, in every continent there is a demand for "Bass's Ale," and it would be easy to add almost indefinitely to a list of the names which have been rendered of great worth by the care and skill of their owners in making a good article and advertising it well. Around these makers of reputation there have sprung up, like parasites, a crowd of imitators, seeking, by various fraudulent devices, to divert to themselves a little of the trade destined for the manufacturer whom they copy.

Courts of equity have been constantly called upon to suppress new and original methods of accomplishing the same old purpose of deception. On the whole, they have moved steadily forward in the direction of preventing any fraud whatever, but the progress has been sometimes slow and hesitating through fear of unduly hampering and embarrassing fair and reasonable competition.

A class of cases which presents peculiar difficulties is that which forms the subject of this article. If a man whose name is "Bass" sets out to make and sell ale in competition with the genuine, and adopts bottles of the usual shape, the identity of name will alone deceive numbers of purchasers who want "Bass's Ale," but do not observe the details of the labels. How far can the courts go in protecting the original maker against this deceptive and damaging competition without unduly trenching on the right of the second Bass to use his own name and to carry on any lawful business? The answer towards which the judges are steadily moving is that the new maker must so differentiate his goods from the original that they will not deceive, or, at least, must make reasonable efforts to diminish the deception which will naturally follow from the similarity of name.

The inherent difficulty in dealing with such cases has been frequently increased by speaking as if they involved questions of trademark, a closely analogous, but yet materially different subject.

A trademark is an arbitrary, distinctive mark affixed to the goods by the manufacturer or distributor to indicate their origin. The first person to use such a mark has an exclusive right to it as applied to the particular articles in question, so that it has even been said that he has a property right in it, and that it is because imitations interfere with this right that the court protects him against them.¹ The more accurate opinion, both historically and as a matter of principle, is that the injury to the plaintiff's trade by any uncalled-for imitation of his names, colors, or other indicia, causing the defendant's goods to pass as the plaintiff's is a fraud, and that this fraud is the basis of the court's jurisdiction.² But as applied to a true trademark, consisting of an arbitrary name or symbol, the latter opinion usually leads to the same practical results as the former, because the imitation of such a distinctive mark by a competitor is never justifiable, and, if continued after notice that it deceives, is clearly a fraud, so that on either view an injunction necessarily follows. The result is that, for many purposes, and subject to certain qualifications, there is practically property in a trademark strictly so called.

It is not, however, every name or mark which can be thus appropriated to the exclusion of the rest of mankind; such a monopoly of any word which a new maker would naturally wish to use in describing his product would be intolerable. For example, there can be no trademark in geographical names indicating the locality where the product to which they are applied grows or is manufactured, nor in words indicating that an article is made under certain patents, or, more correctly, the presumption of fraud which arises from the imitation of a peculiar and distinctive mark does not arise when the word copied is a natural and appropriate appellative.³ In the latter case the mere use of the word is not necessarily wrongful; the plaintiff must show something more in

¹ See opinion of Lord Westbury, in *Hall v. Barrows*, 4 DeG. J. & S. 150, 158, and opinion of Fuller, C. J., in *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 138 U. S. 537, 548.

² See per Holmes, J., in *Chadwick v. Covell*, 151 Mass. 190, 193; per Blackburn, in *Singer Mfg. Co. v. Loog*, L. R. 8 App. Cas. 15, 29, *et seq.*

³ Cf. *Coffman v. Castner*, 87 Fed. Rep. 457.

order to maintain his right to relief. The simplest way to show that the acts of the new maker are wrongful is to prove that he is using the word untruthfully; no honest occasion for adopting it can then exist,¹ and the court will interfere, not because of the fraud upon the public, but to prevent the unnecessary, and therefore wrongful, imitation of the plaintiff. Many other instances at once suggest themselves in which unfair competition by means of deceptive devices which are not infringements of any trademark will be enjoined. For example, imitations of the capsule of a champagne bottle, or of the shape of a box, have been prevented,² and so have certain deceptive uses of geographical names, and other descriptive words, which were not, strictly speaking, untruthful.³

The fraudulent use of his own name is a special example of the unfair use of a word which a new maker has a right to employ fairly. No difficult question arises except when he is using his own true name either alone or as part of the name of a firm of which he is really a member. If he has assumed the name, even by leave of court, the use of it in any way whatever in competition with an old maker will be enjoined;⁴ a corporation, which can choose its own name, will not be allowed to use one similar to that of any existing concern in the same line of business,⁵ and of course the purchase of a name, either by means of a fictitious partnership or in any other way, will not confer any right to use it if it too closely resembles that of an earlier dealer.⁶ Deception and injury caused in any of these ways are needless and unjustifiable, and will therefore be prohibited as a matter of course. But a man himself has a certain right to use the name with which he is born in any business which he actually carries on, even if he incidentally deceives the public and injures an earlier dealer; and

¹ See, for example, *Newman v. Alcord*, 51 N. Y. 189, in which it is held that a manufacturer of cement at Akron, who called his product "Akron Cement," could enjoin a manufacturer at Syracuse from imitating the name. Cf. acc. *Pillsbury & Washburn Flour Mills v. Eagle*, 86 Fed. Rep. 608; *Birmingham Vinegar Brewery Co. v. Powell*, [1897] App. Cas. 710; *California Fig-Syrup Co. v. Worden*, 86 Fed. Rep. 212, and cases cited.

² *Von Mumm v. Frash*, 56 Fed. Rep. 830; *Baker v. Baker*, 77 Fed. Rep. 181.

³ *Atwater v. Castner*, 88 Fed. Rep. 642.

⁴ *Pinet v. Pinet*, [1898] 1 Ch. 179.

⁵ *Hendriks v. Montagu*, 17 Ch. D. 638; *Holmes, Booth, & Haydens v. Holmes, Booth, & Atwood Mfg. Co.*, 37 Conn. 278; *Charles Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462; *Wm. Rogers Mfg. Co. v. R. W. Rogers Co.*, 70 Fed. Rep. 1017.

⁶ *Melachrino v. Melachrino & Co.*, 4 Pat. Rep. Eng. 215; *Sawyer v. Kellogg*, 7 Fed. Rep. 720.

the extent and limitations of this right have been the subject of many adjudications.

In the comparatively early case of *Croft v. Day* (1843),¹ we find some of the principles stated and applied. The plaintiff was the manufacturer of Day & Martin's blacking. The defendant's name was Day, and by an agreement with a friend named Martin he was making blacking under the name of "Day & Martin," and using packages similar to those of the plaintiff. No fac-similes are given in the report, nor is there even a full description of the labels, but the following quotation from Lord Langdale's frequently cited opinion shows the scope and purpose of the decision: —

"It has been very correctly said that the principle in these cases is this. That no man has a right to sell his goods as the goods of another. You may express the same principle in a different form, and say that no man has a right to dress himself in colors, or adopt and bear symbols to which he has no peculiar or exclusive right, and thereby personate another person for the purpose of inducing the public to suppose either that he is that other person, or that he is connected with and selling the manufacture of such other person, while he is really selling his own. It is perfectly manifest that to do these things is to commit a fraud, and a very gross fraud. I stated upon a former occasion that, in my opinion, the right which any person may have to the protection of this Court does not depend upon any exclusive right which he may be supposed to have to a particular name, or to a particular form of words. His right is to be protected against fraud, and fraud may be practised against him by means of a name, though the person practising it may have a perfect right to use that name, provided he does not accompany the use of it with such other circumstances as to effect a fraud upon others."

By the terms of the injunction the defendant was restrained from selling any composition described as, or purporting to be, blacking manufactured by Day & Martin, in bottles having affixed thereto the labels complained of, or any other labels so contrived or expressed as to represent the composition sold by the defendant to be the same as that sold by the complainant.²

In that case the wrongful character of the defendant's acts was apparent and there can be no question of the correctness of the

¹ 7 Beav. 84.

² This decision is followed and similar injunctions granted in *Clayton v. Day*, 26 Solicitors Journal, Pt. 1, 43 (1881); *Clayton v. Day*, 76 L. T. J. 79 (1883); *Schweitzer v. Atkins*, 37 L. J. Ch. 847, 848 (1868); *James v. James*, L. R. 13 Eq. 421 (1872); *Fullwood v. Fullwood*, Weekly Notes for Law Reports, 93 (1873); *Fullwood v. Fullwood*, 9 Ch. D. 176 (1878); *Holloway v. Holloway*, 13 Beav. 209 (1850).

decision. In *Burgess v. Burgess*,¹ on the other hand, we have an instance in which the acts of the defendant were deceptive and probably fraudulent, but where nevertheless relief was refused because he was not doing anything with which the court felt justified in interfering. The plaintiff had for many years been selling at No. 107 Strand a sauce for fish which he called "Essence of Anchovies." The defendant, the plaintiff's son, established himself as a rival, and placed over his door a plate with the words "Burgess Fish Sauce Warehouse, late of 107 Strand," and sold his sauce under the name "Burgess's Essence of Anchovies." On an application for an injunction, Kindersley, V. C. restrained the defendant from continuing the use of the door-plate, and the words "Late of 107 Strand," but refused to prohibit the name "Burgess's Essence of Anchovies." The Lord Justices affirmed this decision, Lord Justice Knight Bruce, saying, "All the Queen's subjects have a right, if they will, to manufacture and sell pickles and sauce, and not the less that their fathers have done so before them. All the Queen's subjects have a right to sell these articles in their own names, and not the less so that they bear the same name as their fathers; nor is there anything else that this defendant has done in question before us." The court referred to the circumstance that the motion was a preliminary one as an additional reason for refusing the injunction, and this is not the only instance in which plaintiffs in these cases have failed on a preliminary motion who might perhaps have succeeded had they waited until all the details were brought out on a final hearing. Still there can be no doubt that this decision is not what we should expect to see rendered now on similar facts; perhaps the principles of law would be stated in the same language, but their application would be likely to lead to a different result, because less close imitations are now regarded as deceptive and enjoined. It is noticeable that as a rule the more cases of this kind a court has before it, the less hesitation there is in prohibiting any unnecessary similarity. Experience satisfies the judges that such resemblances are not accidental, and they are not inclined to give the wrongdoer the benefit of any doubt there may be as to the success of his design. In a case like the Burgess case, the new maker would probably now be required to use his christian name and to refrain from any such combination of the name Bur-

¹ 3 De G. M. & G. 896 (1853).

gess with the words "essence of anchovies" as would cause his product to be known as "Burgess's Essence of Anchovies."¹

The character of the plaintiff's trade may have been a factor in the decision. Different articles are sold to different classes of persons and according to the education and carefulness of the purchasers is the degree of distinction necessary to protect the old maker. A striking application of this rule is found in the case of *Johnston v. Orr Ewing*,² relating to the imitation of a ticket on cotton goods, the *ratio decidendi* of which is thus stated by Lord Selborne. "But although the mere appearance of these two tickets could not lead any one to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India unable to read and understand the English language, as equally symbolical of the plaintiffs' goods."

Most things are probably now sold to a larger, more heterogeneous and less careful class than they were when *Burgess v. Burgess* was decided. A man's trade is no longer confined to his own neighborhood, but is often world-wide, and in this fact lies one of the grounds for the increased strictness of the courts in preventing imitations.³

We can see the progress in England from two recent decisions of the House of Lords on the closely related subject of the unfair use of descriptive names.

In *Montgomery v. Thompson*,⁴ it appeared that the plaintiffs and their predecessors had for a hundred years carried on a brewery at Stone, and their ale had become known as "Stone Ale." The defendant built a brewery at Stone over which he placed the words "Montgomery's Stone Brewery," with a device containing the words "Stone Ale" and a monogram somewhat resembling the plaintiff's trademark. An injunction was granted against carrying on the business of a brewer at Stone under the title of "Stone Brewery" or "Montgomery's Stone Brewery" or

¹ *Reddaway v. Banham*, [1896] App. Cas. 199; *R. W. Rogers Co. v. Wm. Rogers Mfg. Co.*, 70 Fed. Rep. 1017; *Baker v. Baker*, 77 Fed. 181; *Baker v. Sanders*, 80 Fed. Rep. 889.

² L. R. 7 App. Cas. 219, 225.

³ As is said by Putnam, J., in *LePage Co. v. Russia Cement Co.*, 51 Fed. Rep. 941, 945 ff. "The difference is between dealing with a local community understanding all the circumstances, and dealing with the great public, scattered throughout the United States, with no opportunities of information, except what is communicated to them by the word, 'LePage' in combination with the word 'glue.'"

⁴ [1891] App. Cas. 217.

under any other title so as to represent that the defendant's brewery was the plaintiff's brewery, and from selling any ale or beer not the plaintiff's under the names "Stone Ales," or "Stone Ale," or in any way so as to induce the belief that such ale or beer was of the plaintiff's manufacture. In the course of his opinion Lord Herschell says "The respondents are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so, because the practical effect of such restraint may be much the same as if the person seeking the injunction had a right of property in a particular name."

Reddaway v. Banham,¹ is an even more striking case. The plaintiff was the manufacturer of "Reddaway's Camel Hair Belting" and for many years had succeeded in preventing rival makers of belting from using the name "Camel Hair," all parties assuming that as applied to belting it was a fancy name. The defendant Banham stamped his belting "Camel Hair Belting" with no other name or distinguishing feature. Reddaway applied for an injunction and, to every one's surprise, the defendant succeeded in proving at the hearing that his belting and also the plaintiff's was chiefly made of camel's hair so that the name was not fanciful or arbitrary, and the defendant insisted that he used it simply to describe his product truthfully and correctly.

The case was left to a jury to find answers to certain questions and they found as follows:—

"Q. 1. Does camel hair belting mean belting made by the plaintiffs as distinguished from belting made by other manufacturers?

"A. Yes.

"Q. 2. Or does it mean belting of a particular kind without reference to any particular maker?

"A. No.

"Q. 3. Do the defendants so describe their belting as to be likely to mislead purchasers and to lead them to buy the defendants' belting as and for the belting of the plaintiffs?

"A. Yes.

"Q. 4. Did the defendants endeavor to pass off their goods as and for the goods of the plaintiffs so as to be likely to deceive purchasers?

¹ [1896] App. Cas. 199.

"A. Yes."

Upon this evidence, Collins, J., granted an injunction restraining the defendants from continuing to use the words "Camel Hair" in such manner as to deceive purchasers into the belief that they were buying the belting of the complainant's manufacture and thereby passing off their belting as and for the belting of the complainant. The court of appeals¹ reversed this decision and entered judgment for the defendant. The House of Lords, on the other hand, reversed the decision of the court of appeals, declared that judgment ought to be entered for the plaintiff and ordered an injunction restraining the defendants from using the words "Camel Hair" as descriptive of, or in connection with, belting manufactured by them or either of them, or belting not being of the plaintiff's manufacture sold or offered for sale by them or either of them without clearly distinguishing such belting from the belting of the plaintiff.

Halsbury, L. C., said, "For myself, I believe the principle of law may be very plainly stated, and that is, that nobody has any right to represent his goods as the goods of somebody else. How far the use of particular words, signs or pictures does or does not come up to the proposition which I have enunciated in each particular case must always be a question of evidence; and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact the legal consequence appears to follow."

Lord Herschell discusses the matter more fully. Commenting on the statement of the Master of the Rolls that you cannot restrain a man from telling the "simple truth;" and that this was all the defendants had done when they called their belting "Camel Hair Belting," he says, "I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification differing from its primary one, and that if it is used to persons in the trade who will understand it and be known and intended to understand it in its secondary sense it will none the less be a falsehood that in its primary sense it may be true. A man who uses language which will convey to persons reading or hearing it a particular idea which is false, and who knows and intends this to be the case, is surely not to be absolved from a

¹ Lord Esher, M. R., Lopes and Rigby, L. JJ.

charge of falsehood, because in another sense which will not be conveyed and is not intended to be conveyed, it is true."¹

This exposition of the law by the House of Lords is especially interesting because the facts had been found by the jury, and the court had only to determine whether the evidence justified the verdict, and if so, whether the verdict warranted an injunction. Usually such cases come before a tribunal which passes on both law and fact, and perhaps the lords might have hesitated at finding, as the jury in substance did, that the use of two simple English words accurately describing the defendant's product was deceptive and that the words were used with the intention of passing off the goods as those of the plaintiff. But they did not feel any doubt that the evidence supported such a verdict nor that on such a verdict an injunction must issue.

The House of Lords has not yet had occasion to apply the principles enunciated in *Reddaway v. Banham* to cases of rival traders of the same name; but there can be little doubt that they will so apply them unhesitatingly when the occasion arises; and in that very case Lord Herschell classes a man's own name with other examples of descriptive words which must not be used deceptively, saying: "*The name of a person*, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the

¹ During the argument this interesting colloquy occurred :

Asquith, Q. C. "When once you have established this proposition that the secondary meaning of this term had become the dominant meaning, that is to say, that 'Camel Hair Belting' was understood in the market as belting made by the plaintiffs, and not merely as belting made of camel hair, then any person using that name in that market, even though he might do it innocently—(Lord Herschell.—Innocently, at any rate, until he found that he was interfering with somebody else.) Yes; the moment his attention is called to the fact that he is interfering with some other person, from that moment his user becomes illegal. (Lord Herschell. Then comes the question whether from that time he does it honestly. He may accidentally do it of course, but when he finds that he is deceiving people he is not entitled to go on doing it.)" 13 Rep. Pat. Eng. 223.

defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."

There are three recent decisions on this subject in the English court of appeals, of which the most interesting is *Brinsmead v. Brinsmead*.¹

The Brinsmead family, who, in 1894, were represented by the plaintiffs John Brinsmead & Sons, had been for sixty years in the business of making pianos, and "Brinsmead pianos" were famous. Thomas Edward Brinsmead and his sons George and Sidney Brinsmead were employed by the firm. In October, 1894, they left that employ, and became themselves manufacturers of pianos, in partnership with one Wilcox, under the name of T. Brinsmead & Sons. John Brinsmead & Sons applied for an injunction which was granted by Romer, J., prohibiting all the members of the new firm from carrying on the business of pianoforte manufacturers or dealers under the name of T. Brinsmead & Sons, or under any name so closely resembling the plaintiff's name as to be calculated to lead to the belief that the business carried on by the defendants was the plaintiff's business, "or under any name or style of which the word 'Brinsmead' forms a part, without also adding thereto the words 'Thomas Edward,' or other the full Christian name of the oldest member of the firm whose name may be Brinsmead and without also including as part of the name or style, the surname of every other member of the firm whose name may not be Brinsmead, etc., etc."

After this injunction, Wilcox at once retired from the partnership, and the name Thomas Edward Brinsmead & Sons was adopted by the defendants. They then transferred their business to a corporation "Thomas Edward Brinsmead & Sons, Limited," and immediately proceedings were instituted against this corporation by John Brinsmead & Sons. North, J., granted a preliminary injunction as follows:—From using the name Thomas Edward Brinsmead & Sons, Limited, or the name of Brinsmead in connection with the manufacture, sale or hire of pianos, without adding thereto an express statement that the defendant company are distinct from and have no connection with the old firm of John Brinsmead & Sons." This was affirmed by the Court of Appeals.

In considering the weight to be given to this case it must be remembered not only that there was a great deal of evidence of

¹ 12 L. T. R. 631; 13 L. T. R. 3 (Oct. 28, 1896).

fraudulent intention which undoubtedly had its effect on the minds of the judges, but also that the decision of the Court of Appeals relates to the assumption by the defendant of a corporate name; on the other hand however, the defendant succeeded to the business of a firm and thereby acquired as good a right to use the name as its predecessors had,¹ and, moreover, the order of Romer, J., related to a firm name, and the Court of Appeals not only approved this order, but intimated that they would have granted the same relief against the firm which they did against the corporation; Lord Justice Lindley saying: "it appears to me that when the three Brinsmeads tried to get rid of this order, by getting rid of Wilcox and carrying on business under their own name and selling pianos under their own name of Thomas Edward Brinsmead & Sons, although it might not have been possible to commit them for contempt of this order, I cannot doubt for a moment that Mr. Justice Romer would have made a fresh order restraining them, if it had been supplemented by evidence that the course of business did mislead the public and did induce them to buy the defendant's pianos for the plaintiff's."

The case in all its stages certainly indicates a willingness to go a long way in restraining a man in the use of his own name if the use is deceptive.

There have been two decisions on the subject by the same court in favor of the defendant. The report of *Jamieson v. Jamieson*² is so brief that it is impossible to draw from it any reliable conclusions.³ *Turton v. Turton*⁴ was a bill to enjoin the

¹ *Fish v. Fish*, 87 Fed. Rep. 203.

² 14 L. T. R. 160.

³ Since the above text was in type a full report has been published in 15 Rep. Pat. Cas. (Eng.) 169, from which it appears that there were three manufacturers of harness dressing in Aberdeen all named Jamieson, viz., Peter Jamieson, James Jamieson, and the plaintiffs Jamieson & Co. Peter Jamieson was much the oldest, and when the plaintiffs first started he compelled them by legal proceedings to adopt certain distinguishing features; although their packages and labels remained generally similar to his. The defendant, whose labels the plaintiffs sought to have enjoined had not imitated any of the distinctive points in the plaintiff's labels, but only those common to the trade, and the Court of Appeals thought that if the peculiarities adopted by the plaintiffs were sufficient to prevent their goods from being mistaken for Peter Jamieson's, they must also be enough to distinguish them from the defendant's. The plaintiff's case also presented other difficulties; nevertheless the opinion of Byrne, J., granting an injunction in the lower court, seems more in accord with the progressive spirit shown by the recent decisions of the House of Lords.

⁴ 42 Ch. D. 128.

use of the firm name John Turton & Sons. The plaintiffs had for many years carried on the business of steel manufacturers under the name of Thomas Turton & Sons. The defendant John Turton had for nearly as many years carried on a similar business in the same town, first as John Turton and then as John Turton & Co. In 1888 he took his two sons into partnership with him and carried on business under the firm name of John Turton & Sons. There was no evidence of any imitation of trademarks and labels nor of any other attempts to deceive the public; no objection was made to the use of the name Turton which had been used by the defendant for years and was accompanied by his full Christian name; the only thing asked was an injunction against the use of the words "& Sons." There was some evidence of confusion, but whether any part of this was due to the addition "& Sons" was not made clear. The Court of Appeals refused an injunction without hesitation and in the course of his opinion in *Reddaway v. Banham*, Lord McNaghten expresses surprise that so simple a case was ever reported.

It is in the recent American cases that we find the best instances of the application of the general principles so clearly stated by the House of Lords to imitations of which the keystone is similarity of name. It is true that the distinction between such cases and those involving trademarks strictly so called was at first often overlooked, so that in some early decisions, injunctions were refused for the simple but inadequate reason there could be no trademark in a man's own name. On the whole, however, the results reached have generally been satisfactory. In *McLean v. Fleming*,¹ an important and leading authority, we have a good illustration of a deception worked even more through the ear than through the eye. The complainant as successor to one Dr. McLane, made and sold "McLane's Liver Pills" and "Dr. C. McLane's Celebrated Liver Pills." They were put up in wooden boxes with wrappers on which the names given above were plainly printed in white on a black and white background. The defendant James McLean, put up pills in a somewhat similar box, on which were the words "James H. McLean's Universal Pills, or Vegetable Liver Pills," in white letters, but the arrangement of the letters and the character of the background was different. An injunction was issued and in the course of his opinion Mr. Justice Clifford thus states the

¹ 96 U. S. 245.

basis of the decision. "Chancery protects trademarks¹ upon the ground that a party shall not be permitted to sell his own goods as the goods of another; and therefore he will not be allowed to use the names, marks, letters or other indicia of another, by which he may pass off his goods to purchasers as the manufacture of another."

It would be needless to give here in detail the many similar cases in which injunctions have been granted because the danger of confusion due to the similarity of name between the plaintiff and defendant was increased by the adoption by the defendant of colors, forms and designs used by the plaintiff.² Some of the most important are referred to below in discussing the extent of the relief which should be granted. *Williams v. Brooks*³ is worthy of special notice because the forms of packages used by both the plaintiff and defendant were in general use in the trade, and entirely *publici juris*; but when used by a person of the same name they were deceptive and therefore their use by him was enjoined, although any one whose name was different might have used them freely.⁴

Neither is it necessary to discuss elaborately the numerous cases in which injunctions have been refused.⁵ In one of the latest of these, *Duryea v. National Starch Co.*,⁶ the plaintiff and appellee was the proprietor of the business of manufacturing the well-known Duryea's starch at Glen Cove. The defendants, who were all named Duryea, formed a partnership to make and sell starch under the name Duryea & Co. The case arose on a motion for a preliminary injunction which was granted by the circuit court. The Court of Appeals for the Second Circuit in reversing this decision says:

¹ Throughout the opinion the plaintiff's name and indicia are inaccurately spoken of as a trademark.

² *E. g.* *Landreth v. Landreth*, 22 Fed. Rep. 41; *Stonebraker v. Stonebraker*, 34 Md. 444; *Devlin v. Devlin*, 69 N. Y. 212; *Shaver v. Shaver*, 54 Ia. 208; *Britannia Co. v. Parker*, 39 Conn. 450; *Williams v. Brooks*, 50 Conn. 278; *Meyer v. Bull Vegetable Medicine Co.*, 58 Fed. Rep. 884; *Pillsbury v. Pillsbury*, 64 Fed. Rep. 841.

³ 50 Conn. 278.

⁴ See *Baker v. Baker*, 77 Fed. Rep. 181.

⁵ *E. g.* *Brown Chemical Co. v. Meyer*, 139 U. S. 540; *Gilman v. Hunnewell*, 122 Mass. 139; *Meneely v. Meneely*, 62 N. Y. 427; *Rogers v. Rogers*, 53 Conn. 121; *Rogers v. Simpson*, 54 Conn. 527; *R. W. Rogers v. William Rogers Mfg. Co.*, 70 F. R. 1019; *Duryea v. National Starch Co.*, 79 Fed. Rep. 651; *Fish Wagon Co. v. La Belle Wagon Co.*, 82 Wisconsin, 546.

⁶ 79 Fed. Rep. 651, 652.

"It cannot be denied that by continuous and rightful use for forty years, the name of 'Duryea's Starch' had become identified with its 'source of manufacture,' and that an attempt by persons of the name of 'Duryea' or of any other name, to put upon the market their own product under the name of 'Duryea's Starch' could be suppressed. Inasmuch as the defendants have not called their starch by this well-known name, and have not assimilated the labels upon their packages to those long used by the manufacturers at Glen Cove, the question is whether the defendants have made such an unnecessary and unfair use of the name of 'Duryea' as to deserve the unfavorable criticism of a court of equity."

In the various Rogers cases arising out of imitation of plated forks and spoons and similar articles bearing the name of Rogers, the plaintiffs have encountered two difficulties. First, there are a number of different manufacturers all entitled to use the word "Rogers" so that persons seeking the goods of any particular maker must necessarily scrutinize their purchase carefully. Second, the method of applying the word is to stamp it on the under side of the shank of the fork or spoon, which is much the most natural place. Accordingly, although the word "Rogers" thus stamped is likely to mislead, the courts have not yet seen their way to interfere, provided the imitator uses his initials. He could not be required to stamp his name elsewhere, nor to omit it, and so long as it appears on the shank, it will cause confusion and deceive. Something might be gained by requiring him to use a distinctive name or device which would become the short trade name of the goods, coupling it with a statement that it is made by him; or the form of injunction used in *Brinsmead v. Brinsmead* might be adopted.¹

Wherever relief is granted, this question of the form of the injunction is of great importance. It is always hard to determine what restrictions can reasonably be imposed upon the public to protect a plaintiff's reputation and good will; and those which hamper a man's use of his own name may be very onerous and must be cautiously imposed. There is no difficulty in requiring a defendant to use his full name and to refrain from using any of the plaintiff's colors, forms and symbols. But suppose his christian name is the same as the plaintiff's, or suppose the plaintiff does not accompany his name with any indicia, so that his product can

¹ *Vide supra*, page 252.

only be distinguished by his name. Then the courts must, in order to give adequate protection, require the defendant to take some affirmative action. This they will do if the character of the articles imitated make it possible, but they will not rashly interfere with defendant's business or impose unreasonable restrictions upon him.

In England the usual form of injunction is stated by A. L. Smith, L. J., to be against "selling, etc., without clearly distinguishing his make from the old make."¹ In the United States it can hardly be said that there is any usual form; the Supreme Court in a case relating to the use of the name of a patented sewing machine after the name had become *publici juris* by reason of the expiration of the patent, granted an injunction prohibiting its use, "without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer, and therefore not the product of the Singer Manufacturing Co."² The value of such general decrees as these depends on the construction given them in case of contempt proceedings. If they are interpreted as requiring radical efforts to prevent any one from being misled, such for example as those prescribed in *Picon v. Picon*,³ then they are all that could be desired and the English form at least does seem to require that something effective be done; but the form used in the Singer case might be literally complied with without giving up the phrase "Singer Machines" if the defendant added the words "made by the June Mfg. Co." Such an addition might perhaps be sufficient to prevent deception in the case of a comparatively expensive article such as a sewing machine. But on cheaper commodities, the buyers would often not read beyond the first two words and the defendant's goods would still sell as "Singer's" almost as readily as the genuine. To permit the imitation of such short names used by buyers and sellers to describe the goods is very dangerous; and it is not necessary, as every honest purpose of the defendant could be accomplished by stating that his machine "operates by the Singer method."

In *Meyers v. Dr. B. L. Bull Vegetable Medicine Co.*⁴ the extent of the injunction to be granted was the subject of special consideration by the United States Circuit Court of Appeals of the

¹ 13 L. T. R. 3; cf. however the detail injunctions in the Brinsmead case quoted *supra*, pages 252-3.

² Singer Mfg. Co. v. June, 163 U. S. 169.

³ *Infra*, page 259.

⁴ 58 Fed. Rep. 884.

Seventh Circuit. In the Court below, the respondents had been restrained from using the words "Dr. Bull's Cough Syrup" and other forms of expression containing these words upon any label resembling the labels of the complainant, but not from using the words on labels not resembling the complainant's. It was held in the Court of Appeals that they should be prohibited from using the words on any style of label.

In *Baker v. Sanders*,¹ where the plaintiff was the original manufacturer of Baker's chocolate and the defendant was the agent for one W. H. Baker of Virginia, the United States Circuit Court of Appeals for the second circuit, formulated a very carefully worded injunction against using in connection with the business of making or selling chocolate the word "Baker" with or without initials, "so as to indicate that the chocolate is a variety of 'Baker's Chocolate'; but the defendant may indicate in appropriate language that the chocolate is made, prepared or sold for or by W. H. Baker of Winchester, Virginia."

For special reasons the Court in that case gave the defendant an option, instead of changing his labels, to affix to each package the statement "W. H. Baker is distinct from the old chocolate manufactory of Walter Baker & Co."

In *Baker v. Baker*,² in the same circuit, Judge Shipman granted an injunction in the first form given by the Court of Appeals as above without any alternative.

In *Allegretti v. Keller*,³ the second form was adopted on a motion for a preliminary injunction.

Owing to the French practice of minutely and completely defining the rights and obligations of the parties, some of their decrees are most interesting examples of what justice and fair dealing require in cases of this character.

In *Roederer v. Roederer*,⁴ the plaintiffs Théophile Roederer & Co., of Rheims, were makers of a well-known brand of champagne having a valuable reputation, and defendants organized a partnership under the name of Louis Roederer & Co., to sell champagne, and advertised themselves widely. Louis Roederer had never had anything to do with the manufacture of champagne and was a stranger in the city, so that there was no doubt of fraudulent intention. Nevertheless, as Louis Roederer was a real member of

¹ 80 Fed. Rep. 889.

² 87 Fed. Rep. 209.

³ 85 Fed. Rep. 643.

⁴ Dalloz, Recueil Périodique, 1865, pt. 2, page 87 (Brown Trademarks, sec. 438).

the firm and took part in carrying on the business the court declined to grant an injunction against the use of the name Louis Roederer & Co., but required that the full first name should be used in all cases and also that the words "house founded in 1864" should be added.

In *Société Thérèse Picon et Comp. v. Picon et Comp.*¹ it appeared that the bitters made by Gaetan Picon had acquired a great reputation and become generally known as "Picon Bitters" but sometimes as "African Bitters." Thérèse Picon, a daughter of Gaetan, and her partner undertook to sell bitters under the name of "Thérèse Picon & Company" in competition with the proprietors of her father's business. An injunction was granted prohibiting the defendants from using, either as a mark or in any way in the business of making or selling bitters, the names "Bitters of the daughter Picon" or "Bitters of Thérèse Picon," or "African Bitters" or even "Bitters" alone and requiring them to use "Bitters" followed by some qualification or adjective with the statement underneath "made by Thérèse Picon & Co. House founded in 1888." It was further ordered that the letters in which the words "Bitters" and its qualification were printed should be twice as large as those used for the statement "Made by Thérèse Picon & Co." and that the word "Thérèse" should be printed in letters of the same size and color as the "Picon."

The details covered by this decree are all of importance, especially the efforts to guard against the defendant's goods being known as "Picon Bitters" by requiring the use of some adjective that may become the short trade name of their product and by prescribing a style of printing calculated to produce this effect. These provisions show what the defendant ought to do in order to properly comply with the forms of injunction in use in the American and English courts, which require him in general terms to plainly distinguish his goods from the plaintiff's, and the result should be substantially the same in case proceedings for contempt have to be taken.

It is to be observed that the plaintiff's right to be protected against loss and injury to his trade caused by deception, so far as this protection can be afforded without unreasonably restricting trade, does not depend on any intentional fraud or bad motive of the defendant.

¹ Dalloz, Recueil Périodique de Jurisprudence Générale, 1894 1, page 348 (Cour de Cassation).

Referring to *Sanders v. Baker*, Morrow, J., says in a recent case: "It was held by the Circuit Court of Appeals that one entering into competition with another person of the same name, who has an old and established business, is bound to distinguish his goods from those of the latter, so as to prevent confusion."¹ And this is a correct statement of the effect of that and of other recent decisions, with only the qualification that the defendant is not required absolutely to prevent deception of the public, but only to make real and appropriate efforts to do so. Nothing is said about fraud; the right, as above defined, exists equally, whether the deception is accidental or of set purpose. "Courts, in such cases, do not require proof of any peculiarly iniquitous 'perfidious dealing.' If the representation as to what or whose the goods are is calculated to deceive the purchaser into buying them as goods of the complainant, equity will enjoin its continuance, although the 'deceitful representation' was placed upon them carelessly, or from lack of appreciation of the meaning it would convey to the purchaser, or from an honest mistake as to the defendant's right to use it."²

The rule is the same in England. In *Mitchell v. Henry*,³ Lord Justice James says: "The defendants must bear in mind that the original honesty of intention does not protect the continued user, if the user is found practically to have the result of deceiving, or is calculated to deceive purchasers, because it is very easy for manufacturers to avoid any possibility of misleading the purchasers if they are minded to avoid it."⁴

In *Reddaway v. Banham*, Lord McNaghten refers to the finding of the jury that the defendant endeavored to mislead as not necessary for the relief asked.⁵

One is presumed to intend the consequences which a reasonable man would naturally foresee, and if he begins or continues a deceptive package after the fact that it is injurious has been pointed out, his actions are dishonest, and the only remaining question is whether the deception can be prevented without imposing undue restrictions on business. If it can there is fraud in the sense of a court of equity; otherwise, the plaintiff's loss is due to a decep-

¹ *California Fig-Syrup Co. v. Worden*, 86 Fed. Rep. 212, 216.

² *Tarrant v. Hoff*, 76 F. R. 959, 961. See also 51 Fed. Rep. 947.

³ L. R. 15 Ch. D. 181, 191.

⁴ See also *Army & Navy Soc. v. Co-operative Society*, 8 Patent Reports, Eng. 426. Cf. *Allen v. Flood*, [1898] App. Cas. 1.

⁵ [1896] App. Cas. 219, and vide *ante*, page 249.

tion which cannot be prevented, and the burden must lie where it falls.

No doubt the courts have sometimes been led to grant more stringent decrees than they would otherwise have done, because they were impressed with the defendant's fraudulent character, and convinced that if he were given an inch he would take an ell;¹ but almost all the injunctions above quoted were intended as definitions of the plaintiff's rights irrespective of the defendant's motives.²

It is an important fact, however, which must not be overlooked, that when a business has been begun by imitation, labels and advertisements which would otherwise be innocent may operate as a continuation of the original fraud, and should for that reason be stopped.³ The previous conduct of the defendant is, therefore, in every case one of the circumstances to be considered in determining what form of injunction is appropriate, or what decree should be made in contempt proceedings. Indeed, all the surrounding facts may have a bearing on the question of what efforts should be required of a new maker to prevent his goods from passing as those of the old one. The precautions which would be reasonable and effective in the case of pianos may be unsuitable as applied to flour, and certain articles, such as plated ware, present peculiarly difficult problems.

The cardinal principle that anything which may deceive is *prima facie* wrongful, and should be prevented if possible, is the only safe guide, and it is most encouraging to see that, as the commercial value and importance of long-established business reputations, and the opportunities for making unjust gains by fraudulent imitations are more clearly recognized, the courts are more and more willing to grant the needed protection, and show an uncompromising determination to do their part towards maintaining commercial honesty and fair dealing.

W. L. Putnam.

¹ *Montgomery v. Thompson*, [1891] App. Cas. 217; 8 Patent Reports, Eng. 426, 429.

² (*E. g.* *Reddaway v. Banham*, *Singer Mfg. Co. v. June*, *Baker v. Sanders*, *Baker v. Baker*, 87 Fed. Rep. 209.)

³ Cf. *LePage Co. v. Russia Cement Co.*, 51 Fed. Rep. 941, 946.